

58. (New) The method of claim 53, wherein the information is provided through a database.

REMARKS

Claims 1-39 were pending. Applicants cancel claims 6, 9 through 18, and 32 through 39. Applicants amend claims 1 through 3, 5, 7, 19, 20 through 22, and 27 through 29. Applicants add claims 40 through 58. Thus claims 1 through 8, 19 through 31, and 40 through 58 are now under examination. Applicants reserve the right to prosecute the canceled claims at a later date in a continuation or divisional application.

Support for the amendments to the claims may be found throughout the specification. Support for the amendment to claim 1, for example, can be found at pages 6 through 9 of the application. Support for the amendment of claim 2 and of claim 7 may be found, for example, at pages 17-18 of the application. Claims 3, 5, 19, 20, 21, and 22 have been amended for the sake of clarity and thus find support in the corresponding unamended claim. Claims 27, 28, and 29 have been amended to properly refer to the claims from which they depend. The amendments introduce no new matter.

Support for the new claims may be found throughout the specification. Support for new claims 40-49 may be found, for example, on pages 23 through 29 of the application. Support for new claim 49 may be found, for example, on pages 21-22 and 30 of the application. Support for new claim 50 may be found on pages 4, 5, 7, 8, 18, and 34-39 of the application, as well as in canceled claims 35-39. Support for new claims 51-58 may be found on pages 18 and 37-39 of the application. The new claims introduce no new matter.

Rejections under 35 USC 101

Examiner rejects claims 30, 31, and 35-39 as being non-statutory subject matter.

Applicants have canceled claims 37 through 39. Thus the Examiner's rejections to claims 37 through 39 are mooted. Applicants have canceled claim 35 and 36, but add new claim 50 that covers similar subject matter to claims 35 and 36. Applicants will thus address the Examiner's rejections to claims 30, 31, 35, and 36. Applicants reserve the right to prosecute the canceled claims in a divisional or continuation of the application.

Applicants respectfully submit that the Examiner has not established that the rejected claims are unpatentable subject matter. Section 101 is intended "to extend to 'anything under the sun that is made by man.'" State Street Bank & Trust Co. v. Signature Financial Group, Inc., 47 USPQ2d 1596, 1600 (Fed. Cir. 1998), quoting Diamond v. Chakrabarty, 447 US 303, 309 (1981). The Supreme Court has identified three categories of unpatentable subject matter: "laws of nature, natural phenomena, and abstract ideas." State Street, 47 USPQ2d at 1600, quoting Diamond v. Diehr, 450 US 175, 182 (1981). None of the claims rejected by the Examiner under 35 USC 101 fall into these categories. The Supreme Court has never read a limitation into section 101 that "data processing" or "software" be included as a condition of patentability for any kind of method patent, related to business methods or otherwise.

Section 101 requires that subject matter is patentable if it is a "new and useful process, machine, manufacture, or composition of matter." Nothing more is required. Neither computers nor data processing are required by the statute. The Examiner has failed to establish—or even assert under section 101—that the claims rejected under section 101 are neither new nor useful or that they somehow otherwise fail to meet statutory standards for patentability. Instead, the Examiner merely asserts that the claims are directed to

nonpatentable subject matter because they represent a “method of doing business” and do not also include the use of “data processing” or “software.” Applicants respectfully submit that the Examiner’s unsupported assertions are insufficient bases for a rejection under section 101. Applicants urge the Examiner to reconsider his rejections, keeping in mind that “it is improper to read limitations into Section 101 on the subject matter that may be patented where the legislative history indicates that Congress clearly did not intend such limitations.” State Street, 47 USPQ2d at 1600. Applicants further respectfully direct the Examiner’s attention to MPEP § 2106:

Claims should not be categorized as methods of doing business. Instead, such claims should be treated like any other process claims, pursuant to these Guidelines when relevant.

Claims 30, 31, and 35-39 are process claims and should be treated as such. No authority exists administratively, by statute, or judicial fiat that requires as a condition of patentability that any process or method claims contain “data processing” or “software” elements. The relevant Guidelines require that:

The claimed invention as a whole must accomplish a practical application. That is, it must produce a “useful, concrete and tangible result.” State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02.

The rejected method claims accomplish the imprinting of a brand or the development of a specialized market, which are useful, concrete, and tangible results in the context of a business. Applicants respectfully direct the Examiner to MPEP § 2106, and submit that the Examiner has not made a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result:

A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See *In re Warmerdam*, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). See also *Schrader*, 22 F.3d at 295, 30 USPQ2d at 1459. Office personnel have the burden to establish a *prima facie* case that the

claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101. Compare *Musgrave*, 431 F.2d at 893, 167 USPQ at 289; *In re Foster*, 438 F.2d 1011, 1013, 169 USPQ 99, 101 (CCPA 1971).

Applicants respectfully submit that the method claims useful, concrete, and tangible results in the context of a business and therefore respectfully request reconsideration of this rejection.

Claims 30 and 31 are directed to a novel, useful, and nonobvious method of intraprocedural brand imprinting wherein a client's experiences with certain visual, functional, and organoleptic properties of branded items are exploited during an image-enhancing procedure. Structured and carefully orchestrated presentation of the visual, functional, and organoleptic properties of branded compositions or devices employed during the image-enhancing procedure with the experience of image enhancement favorably disposes the client to purchase compositions or devices that bear the same brand and similar visual, functional, and organoleptic properties. Certain embodiments of this new and useful intraprocedure brand imprinting method are disclosed in the application on pages 31-34. The claimed invention describes a new and useful method of marketing image enhancement products by carefully controlling the timing and quality of a client's interactions with certain specific compositions and devices having certain specific characteristics during an image-enhancing procedure, as, for example, disclosed in the cited pages of the application. Intraprocedural brand imprinting produces a useful, concrete, and tangible result—the sale of branded image enhancement products to a selected subset of the market.

Applicants respectfully submit that the Examiner's rejections of claims 35 and 36 (and by implication any expected rejection of new claim 50) are improper for the reasons cited above for claims 30 and 31. Claims 35 and 36 (and 50) are directed to a new and useful

method of market development. As above, the Examiner merely asserts, without any support or rationale, that these claims do not contain patentable subject matter under section 101.

Applicants respectfully submit that such unsupported assertions are insufficient bases for a rejection under section 101. Although applicants assert that no “data processing” or “software” element must be added as a condition to patentability of the claimed method, Applicants assert that new claim 51 (and new claims 52 through 58, depending from claim 51), are amenable to automation or implementation by software or computing devices. Claim 51 and its dependent claims 52-58 comprise a new and useful method of marketing tooth whitening services through an information collection and dissemination service that may be implemented telephonically, through web sites or email, as well as through traditional mail. Although Applicants do not believe the method should be so limited, Applicants assert that embodiments employing internet functionality conform to the Examiner’s preference for “software” –related methods and thus should avoid the Examiner’s rejection based on section 101.

In light of the above, Applicants respectfully request reconsideration of the Examiner’s rejections under section 101.

Rejections under 35 USC 112, Second Paragraph

The Examiner rejected claim 18 as indefinite due to redundancy with claim 17. Applicants have canceled claim 18 and respectfully submit that the Examiner’s rejection of claim 18 is rendered moot. The Examiner rejected claim 25, contending that “192” is unclear.

Applicants assert that claim 25 is not indefinite, and direct the Examiner’s attention to the definition of Whitening Productivity Coefficient (WPC) on page 12 of the application.

The Examiner is further directed to employ the formula on page 12 and the data presented in Table II on page 13 in order to establish at least one method whereby a WPC of 192 may be obtained. Applicants respectfully submit that claim 25 is not indefinite and request reconsideration of the Examiner's rejection.

Rejections under 35 USC 103

Claims 1-6, 16, 19, 23-26 and 32-34 are rejected as being unpatentable over Murljadic (U.S. Patent No. 5,766,006) in view of Roggenkamp (U.S. Patent No. 4,448,307). The Examiner contends Murljadic shows a method for providing tooth whitening but does not show simultaneously administering the method to more than one patient. Examiner contends Roggenkamp discloses it is known that dentists simultaneously provide treatment to more than one patient. Examiner contends it would be obvious to one skilled in the art to modify Murljadic in view of Roggenkamp to more efficiently treat patients.

Applicants have obviated the Examiner's rejections with regard to claims 6 and claims 32-34 by canceling those claims without prejudice to prosecute at a later date. Claim 16, though canceled, is analogous to new claim 49 that depends from new claim 40.

Applicants respectfully disagree with the Examiner's assertions. Murljadic discloses a system for detecting tooth shades in connection with restorative methods for matching materials to patient tooth color. Murljadic does not teach, suggest, or disclose methods for administering a tooth whitening service from a tooth whitening module comprising at least two workstations nor methods where a dental professional administers a tooth whitening service to a plurality of clients by means of a tooth whitening module.

Applicants respectfully assert that the Examiner mischaracterized Murljadic by stating that Murljadic "shows a method for providing tooth whitening," because nowhere does

Murljadic disclose any methods of tooth whitening. Merely noting that the shade of a patient's tooth can be determined after tooth whitening (Murljadic, column 3, lines 31-47), without more, does not render the asserted claims, including amended claim 1, obvious. The same arguments support patentability of new claim 40 (analogous to canceled claim 6).

Applicants disagree that column 1, lines 10-19 of Murljadic render claim 2 or claim 4 of the present invention obvious. Murljadic refers to "reconstructive work," the "reconstructive process," and "restoration" (column 1, lines 16, 17, and 19), and refers to selection of tooth color in the context of "bonding or filling a tooth" (column 1, lines 36-37), "composite materials required for the restoration" (column 1, lines 37-38), prostheses such as a "crown, bridge or denture" (column 1, line 40), and a plethora of other indicia throughout the application that indicate the focus of the Murljadic disclosure is not concerned with an evaluation of image-enhancing tooth whitening procedures, evaluation of oral health and suitability for the whitening method of the present invention, and associated processes as opposed to color matching methods employed in tooth restoration addressing matching the colors of composites, crowns, bridges, dentures, or the like. Moreover, nowhere does Murljadic enable, teach, disclose, or suggest procedures or methods for tooth whitening, or business processes comprising such procedures. Murljadic merely mentions that tooth shades may be measured before and after tooth whitening, without more.

Applicants respectfully disagree with the Examiner's assertion that, as to claim 3, the specific location of the evaluation aspect of the inventive method is "an obvious matter of choice in the place that a known method is applied." Applicants respectfully assert that the Examiner failed to appreciate the inventive aspects of Applicant's method. Applicants' inventive process comprises a clearly defined series of optimized steps combined in order to maximize the ability of a tooth whitening service facility to provide tooth whitening services

in the course of fixed time periods, for example, an eight hour day (see, for example, pages 43-44 and Table VI), as measured by a Whitening Productivity Coefficient. The method is thus directed to a carefully controlled and standardized process that directs the flow of clients through tooth whitening services employing a tooth whitening module through a series of steps to maximize the Whitening Productivity Coefficient, or WPC, of a tooth whitening service facility (see, for example, pages 11-30 of the present application, and Tables II, IV and VI) and thus maximize the quality and profitability of a facility or office performing tooth whitening services through servicing multiple clients through a at least one tooth whitening module comprising at least two workstations and a single dental professional. Thus, the placement or location of an evaluation is an important consideration that affects the WPC and thus the quality and profitability of the tooth whitening facility as described in certain embodiments of the present invention.

As to the Examiner's assertion that claim 3 is obvious because the specific location of an evaluation is an "obvious matter of choice," Applicants respectfully inform the Examiner that, currently, in a dental or medical office the usual and familiar procedure is to be pre-evaluated by the nurse or dental assistant in the same room and chair/bed in which the main examination or procedure is performed. Claim 3 distinguishes itself from the status quo by designating specific locations and timing for different steps of the procedure, thereby improving the efficiency of the treatment.

Applicants respectfully disagree that column 3, lines 31-46 of Murljagic render claim 16, or new claim 49, of the present application obvious. Murljagic does not teach, disclose, or suggest methods for tooth whitening or processes for providing tooth whitening services wherein a tooth whitening method is administered employing at least one module comprising two workstations and a single dental professional. Merely because claim 16 or 49 include

evaluation of tooth shade color as a method step in tooth whitening, this does not render the challenged claims obvious.

Applicants assert that the same is true of claim 26, if not more so. One embodiment of the processed flow of clients through the multi-step method comprises a pre-whitening evaluation that may be conducted in a tooth whitening center space or module that is specifically designed for evaluation of clients in either a standing or sitting position. Thus, the option of evaluation in a sitting or standing position is an aspect of the invention that affects the process flow, the number of clients that can be processed per unit time, and thus the Whitening Productivity Coefficient and the overall profitability of the particular facility under a given set of conditions. The important variable of posture selection during evaluation affects process flow is thus patentably distinct from the cited prior art. Applicants respectfully disagree with the Examiner that the effect of client posture during pre-whitening evaluation in a standardized, process-flow controlled tooth whitening method carried out in a tooth whitening facility optimized for maximal Whitening Productivity Coefficient is well known in the art.

Applicants submit that the Roggenkamp disclosure (U.S. Patent No. 4,448,307) does not either alone or in combination with any other reference render the challenged claims obvious. Roggenkamp is directed to an apparatus for dental supplies and tools—in short, a box for carrying dental equipment useful when a dentist moves from one room to another to treat patients. Roggenkamp's statement that "it is frequently necessary for the dentist to perform treatment upon several patients practically simultaneously, with such patients being located in adjacent rooms of the dental office," (column 1, lines 25-28), does not render the present invention obvious, either alone or in combination with Murljadic, or with any other reference. The present invention is not merely directed to the treatment of more than one

patient at a time by a single dentist. The present invention, in its fundamental embodiments, comprises providing tooth whitening services to a plurality of clients by providing a tooth whitening module comprising at least two workstations operated by a dental professional. Roggenkamp does not teach or suggest a module as set forth in the pending claim 1.

The Examiner rejects claims 7, 8, 10, 14, and 15 as being unpatentable over Murljagic in view of Roggenkamp as applied to claim 1 and further in view of Kutsch. Applicants respectfully disagree with the Examiner. Applicants assert that these claims are patentable for the same reasons that pending claim 1 is patentable. The Kutsch disclosure is directed at colored indicator compositions for tooth whitening pastes, and discloses a tooth bleaching method that includes washing the tooth surfaces with pumice (column 11, lines 40-44). Kutsch does not teach, enable, disclose, or suggest whitening all cosmetically visible teeth of a client simultaneously, as set forth in claim 10 or new claim 40. Indeed, the light bleaching process disclosed in Kutsch is not amenable to simultaneous application to all cosmetically visible teeth. The Kutsch method entails individually irradiating each tooth of a client separately for cycles varying from 60 seconds to five minutes (see, for example, column 12, lines 5-25), which would be lengthy and cumbersome to carry out simultaneously on all cosmetically visible teeth. The Kutsch disclosure implicitly recognizes this, as single tooth bleaching is reflected in the claims (see, for example, column 18, lines 4-5, 7, 17, 21, 28, 33, and 40). Thus, Kutsch does not suggest simultaneously bleaching two or more teeth. The fact that Kutsch discloses that tooth surfaces should be cleaned does not teach, disclose, or suggest the combination of priming with the tooth whitening process of the present invention. Merely because the present invention also discloses priming prior to whitening does not render it obvious in light of Kutsch, even when viewed, as suggested, together with Murljagic and Roggenkamp. Likewise, neither canceled claim 10 nor new claim 41 of the present

invention is obvious in light of Kutsch because the present invention may employ multiple applications of whitening gel and irradiation. In claim 41, the irradiation of all of a client's cosmetically visible teeth are conducted simultaneously. Again, Kutsch does not teach, enable, disclose or even suggest whitening more than a single tooth at a time in a single client. Neither Murljadic nor Roggenkamp can rescue the Examiner's assertions. Murljadic, as stated above, is directed toward restoration of individual teeth. Roggenkamp is directed toward an article of manufacture employed in *sequential* treatment of patients in different rooms. Likewise, neither canceled claim 14 nor new claim 44 of the present invention is obvious in light of the cited prior art for many of the same reasons cited above for claims 7, 8 and 10. Kutsch discloses protecting the gingival area and one tooth on either side of the tooth being bleached, and does not teach, enable, disclose, or suggest simultaneously bleaching all cosmetically visible teeth at once. According to canceled claim 14 and new claim 44, the entire gingival area surrounding cosmetically visible teeth is isolated.

The Examiner rejects claims 9 and 11 as being unpatentable over Murljadic in view of Roggenkamp as applied to claim 1 and further in view of Nikodem. Applicants use the same argument described to defend the application in view of Kutsch to defend the application in view of Nikodem. Further, Applicants submit that none of the references cited teach, enable, disclose, or suggest a method for tooth whitening wherein all the cosmetically visible teeth are whitened simultaneously. As stated above, Murljadic is directed to imaging of individual teeth with regard to restoration, and Roggenkamp is directed to an article of manufacture employed in *sequential* treatment of more than one patient and is not at all directed to tooth whitening. Nikodem adds nothing to the applicability of Murljadic or Roggenkamp to the present invention. Nikodem is directed to a customized or disposable moldable device for bonding braces to patients' teeth employing light to aid in the curing of adhesives that adhere

brace surfaces to tooth surfaces (see, for example, column 1 lines 15-19). Although Nikodem asserts that such contraption can be employed in tooth whitening, no tooth whitening methods are disclosed but for the use of the claimed device as a light reflective device for irradiating a given subset of teeth in a single patient's mouth (column 3, lines 46-50, column 4 lines 50-60). Moreover, Nikodem does not teach, enable, disclose or suggest methods for simultaneously applying light in a whitening process, as in claims 9 and 11 of the present invention.

The Examiner rejects claims 12 and 13 as being unpatentable over Murljadic in view of Roggenkamp and Kutsch as applied to claim 10 and 11 respectively, and further in view of Cornell. Applicants argue that it would not be obvious in light of Cornell to modify tooth-whitening treatment to 20 minutes as tooth-whitening compositions vary and Applicant is using a unique light-activated tooth-whitening method. Further, Cornell implicitly recognizes that variability in tooth whitening compositions may be reflected in treatment time, disclosing a 5 to 15 minute treatment time specific "for the composition of the present invention" (column 3 lines 44-45). Indeed, the Cornell disclosure further goes on to discuss various essential elements and additives of the composition claimed in Cornell (columns 3 to 5) that may affect treatment time, such as, for example, viability of the hydrogen peroxide (column 3 lines 34-39 and column 4 lines 20-24), sufficient oxidation of the guinea green dye and disappearance of color (column 3 lines 26-34 and column 4 lines 10-15 and 20-24), sufficiency of oxidation of phenolphthalein and appearance of color (column 3 lines 46-52 and column 4 lines 10-15 and 20-24), identity and concentration of accelerators (column 4 lines 1-7 and 25-41), and characteristics of the light employed (column 4 lines 17-20), to name just a few variables. As such, claims 12 and 13 are unobvious.

Examiner rejects claims 17, 18, 28 and 29 as being unpatentable over Murljagic in view of Roggenkamp, Kutsch and Pellico (US Patent No. 5,928,628). Applicants have canceled claim 18, and submit that the Examiner's rejections as to this claim is mooted. Applicants have canceled claim 17 but replaced it with new claim 48, depending from claim 40. Claims 28 and 29 have been amended to depend from new claim 40 and new claim 47, respectively. Claims 28 and 29 and new claims 47 and 48 are patentable for the reasons presented above with respect to claim 40. None of the cited references teach, disclose, or suggest the whitening of all cosmetically visible teeth of a client by simultaneously applying light to all cosmetically visible teeth for a fixed period of time.

Examiner rejects claims 20-22 as being unpatentable over Murljagic in view of Roggenkamp and Cornell. Applicants respectfully disagree with the Examiner's assertion that "[t]he specific time periods used is an obvious matter of choice in the degree of a known parameter to the skilled artisan." Applicants submit that time periods for optimal tooth whitening depend heavily upon the method of tooth whitening used. None of the references cited by the Examiner disclose, enable, teach or even suggest the methods taught by the present invention. Further, the amount of time for a given tooth whitening method is a crucial aspect of a tooth whitening facility's profitability, as reflected in the Whitening Productivity Coefficient tables in the application (see, for example, Tables II, IV and VI on pages 13, 15, and 43). The Examiner is specifically directed to Table VI on page 43, which indicates that conventional dental office methods cannot achieve the efficiency taught by the present invention. None of the references cited, alone or in combination, disclose, enable, teach or suggest the claimed time periods in conjunction with providing tooth whitening services employing a module comprising at least two workstations and one dental professional.

Examiner rejects claim 27 as being unpatentable over Murljadic in view of Roggenkamp and Nikodem and further in view of Prencipe et al. (U.S. Patent No. 5,698,182). Applicants submit that, for the reasons stated above, the cited references do not render claim 27 obvious. Prencipe et al. adds nothing to the references previously discussed above. Prencipe et al. discloses specific calcium alumina compounds having calcium peroxide with, optionally, a plethora of additives (see, for example, Prencipe et al., columns 2 to 4). These additives include, optionally, flavoring agents (Prencipe et al., column 2 lines 29-37). However, Prencipe et al., either alone or in combination with the references already discussed, does not disclose, enable, teach, or suggest combination of flavoring agents in a composition as taught in this application in conjunction with providing tooth whitening services employing a module comprising two or more workstations, wherein the tooth whitening services are provided by a single dental professional.

Applicants: Pilaro *et al.*

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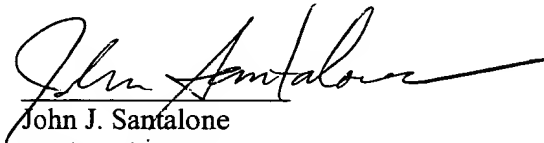
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Conclusion

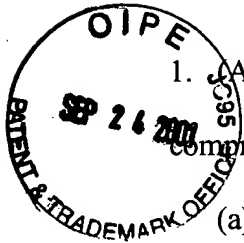
In light of Applicants's amendments and remarks, Applicants respectfully submit that this application is in condition for further examination or allowance. If there are any questions or comments relating to the present application, the Examiner is respectfully invited to contact Applicants's attorney at the telephone number below. No fee other than the fee for the three-month extension of time is believed to be necessary. Applicants hereby authorize the charging of the fee for a three-month extension to Deposit Account No. 11-0171. If any additional fee is required, or overpayment has been made, please charge, or credit, our Deposit Account No. 11-0171 for such sum.

Respectfully submitted,



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MARK-UP OF AMENDED CLAIMS IN ACCORDANCE WITH 37 CFR § 1.121(c)



1. (Amended) A method of providing tooth whitening services to a plurality of clients[, comprising] by one dental professional, which comprises:

- (a) providing [at least one dental professional and at least two tooth whitening stations for each dental professional] a tooth whitening module comprising at least two workstations, each workstation in the module being operated by the dental professional;
- (b) [administering a tooth whitening method simultaneously to more than one client at a time, wherein a single dental professional simultaneously administers tooth whitening to more than one client at a time] assigning each client to a workstation of the module; and
- (c) having the dental professional administer tooth whitening services to each client in each workstation of the module.

2. (Amended) A method according to claim 1, [wherein before step (b),] further comprising evaluating clients prior to administering tooth whitening services.

3. (Amended) A method according to claim 2, wherein clients are evaluated at a location physically removed from the [tooth whitening stations] workstations.

5. (Amended) A method according to claim 4, wherein the step of evaluating [the client further] comprises:

comparing shades in a shade guide to the shade of the client's teeth, and choosing a desired shade as a goal for treatment.

7. (Amended) A method according to claim 1, [wherein preceding step (b) the method] which further comprises priming the teeth of the clients prior to administering tooth whitening services.

19. (Amended) A method according to claim 1, wherein tooth whitening services comprises substantially whitening [the] cosmetically visible teeth of a [plurality of clients] client.

20. (Amended) A method according to claim 19, wherein the [clients'] teeth are substantially whitened in less than about two hours.

21. (Amended) A method according to claim 19, wherein the [clients'] teeth are substantially whitened in less than about ninety minutes.

22. (Amended) A method according to claim 19, wherein the [clients'] teeth are substantially whitened in less than about sixty minutes.

27. (Amended) A method according to claim [9] 8, wherein the prewhitening dentifrice has organoleptic properties designed to be pleasing to a client.

28. (Amended) A method according to claim [10] 40, wherein the whitening gel has organoleptic properties designed to be pleasing to a client.

29. (Amended) A method according to claim [15] 47, wherein the isolation material has organoleptic properties designed to be pleasing to a client.